

Remarks

Claims 36-37 are pending.

Claims 36-37 are appealed.

Claims 36-37 are rejected by the Board based on a new ground – §112, ¶2.

Applicant requests the Examiner consider the definiteness of the pending claims.

Applicant has previously submitted a Showing of Facts and Response to the Board Decision to the Examiner (hereinafter referred to as the Showing and Response). It is unclear whether the Examiner received an untruncated form of the Showing and Response. Accordingly, the substance of the Showing and Response is reproduced in Appendix 1 of this Response.

The Examiner's latest Office Action indicates the Examiner's belief that the Examiner lacks authority to overturn the Board's decision concerning the indefiniteness of the term "splash controller." Applicant contends that the Examiner's belief is in error. The Board itself indicates that the matter can be "reconsidered by the examiner," citing 37 C.F.R. §1.196(b) as authority. (Appeal Decision at p. 8.) The language from that section of the C.F.R. further supports the Board's statement and Applicant's argument. Specifically, 37 C.F.R. §1.196(b) indicates that "[a] new ground of rejection" -- such as the current Board's §112 rejection -- "shall not be considered final for purposes of judicial review." Rather, in such a circumstance, Applicant may submit "a showing of facts" and "have the matter *reconsidered by the examiner*." (37 C.F.R. §1.196(b) (emphasis added).) Section 1.196(b) further indicates that, upon a sufficient showing of facts that were not previously made of record, the Examiner (1) is not bound by the Board's new ground of rejection; and (2) may in fact find that the new ground of rejection has been overcome. (*See also* 37 C.F.R. §1.198 (allowing the Examiner to reopen and reconsider cases under 37 C.F.R. §1.196).) As a result, the Board and Code have expressly granted authority to the Examiner to overturn the Board's decision concerning the indefiniteness of the term "splash controller."

Applicant further contends that the showing of facts that were not previously made of record warrant the Examiner's exercise of such authority. Specifically, the facts not previously made of record show that (1) the Board misquoted the dictionary it relied upon; and (2) the Board's dictionary, other dictionaries, other patents deemed to be known by one of ordinary skill in the art, and the current Specification all demonstrate the definiteness of the term "splash controller" as used in the appealed claims. (*See* Appendix 1.)

The Examiner's latest Office Action also indicates the Examiner's belief that the showing of facts *must* be in accordance with 37 CFR §1.131 or §1.132, which address the submission of affidavits or declarations. Applicant once again contends that the Examiner's belief is in error. As indicated in the Showing and Response, such affidavits or declarations are *permitted* but not required. (See also Appendix 1.) Applicant's argument is supported by the MPEP itself, which uses permissive language twice in the statement addressing the contribution of 37 CFR §1.131 and §1.132 to an appropriate showing of facts.

The "showing of facts" under the rule *may* be a showing under 37 CFR 1.130, 1.131 or 1.132, as *may* be appropriate.

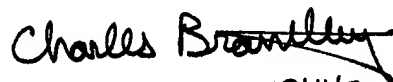
(MPEP 1214.01(I) (emphasis added).) Thus, while the showing of facts "may" include affidavits or declarations addressed in 37 CFR §1.131 or §1.132, such is not a requirement. Applicant submits that the six statements presented (see Showing and Response and Appendix 1) are indeed (1) facts that (2) were not previously made of record and therefore demonstrate the completeness of Applicant's Showing and Response.

As further support for the Examiner's authority to reverse the §112 rejection and the completeness of Applicant's Showing and Response, Applicant cites the prosecution history of another application that recently addressed substantially similar circumstances. In U.S. App. Ser. No. 09/305,865 (hereinafter '865), the applicants appealed the examiner's prior art rejections. (See '865's Appeal Brief transmitted 2/12/02.) The Board refrained from addressing the prior art rejections in favor of raising a new §112 indefiniteness rejection. (See '865's Appeal Decision mailed 7/23/03.) The applicants' subsequent showing of facts was limited to citing dictionary and patent excerpts. (See '865's Showing of Facts and Response transmitted 9/11/03.) The examiner alerted the Board that the claims satisfied §112. (See '865's Response to BPAI's Instruction, mailed 10/08/03. A copy of '865's Response to BPAI's Instruction is included in Appendix 2.) The current facts are analogous in terms of the prior art rejection appealed by Applicant, the §112 indefiniteness rejection raised by the Board, and Applicant's Showing and Response. Accordingly, an analogous outcome is warranted – the Examiner acknowledging the authority to reverse the §112 rejection and the completeness of Applicant's Showing and Response. Applicant contends that the Examiner's actual reversal of the Board's §112 rejection is further warranted given the substantive arguments presented in the Showing and Response as well as Appendix 1.

Conclusion

Given the Examiner's authority to address the Board's new rejection, Applicant requests that the Examiner withdraw the finality of the latest Office Action and exercise that authority. Moreover, given the completeness and substance of Applicant's Showing and Response to the Board's new rejection, Applicant further requests that the Examiner exercise that authority by indicating the claims' definiteness to the Board. If there are any matters that may be resolved or clarified through a telephone interview, the Examiner is requested to contact Applicant's undersigned attorney at the number indicated.

Respectfully submitted,


12/11/13

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Appendix 1:
substance of the previously submitted Showing of Facts and Response to the Board Decision

Pursuant to 37 C.F.R. 1.196(b), Applicant herein presents facts not previously of record and respond to the Board's decision dated July 29, 2003.

I. Showing of facts

Applicant acknowledges that the showing of facts "may" include affidavits or declarations. (MPEP §1214.01.) However, in the interest of efficient prosecution, Applicant contends that the facts below are more than sufficient for the Examiner's determination that the claims satisfy the definiteness requirements of §112, ¶2.

A. MERRIAM WEBSTER'S COLLEGIATE DICTIONARY (10th ed.) defines "configure" as

to set up for operation esp. in a particular way

(*Id.* at p. 242. A copy of the relevant page of MERRIAM WEBSTER is included in an appendix to this Response.)

B. The AMERICAN HERITAGE ELECTRONIC DICTIONARY (1992) defines "configure" as

[t]o design, arrange, set up, or shape

(A printout of the relevant definition from the ELECTRONIC DICTIONARY is included in an appendix to this Response.)

C. The patents listed below state as follows.

1. U.S. Pat. No. 6,311,365 by Dornier states

[w]hen, as is particularly preferred, the steam cleaning head has a delta shape with slightly rounded sides, steam pressure chambers are again arranged side by side along the edge portion and are followed radially on the inside by a suction region. This suction region is defined by a circular annular arrangement of further steam pressure chambers in the interior of which a suction region is again found.

(Dornier at col. 2, ln. 31-37.)

2. European Pat. No. 1238766 by Caspar states

[i]t should be understood that the amount of suction applied to the suction apertures depends on the shape and size of the apertures which preferably are round.

(Caspar at ¶[0013].)

3. U.S. Pat. No. 6,341,387 by Zars states

[a]n additional object of the present invention is that it may be installed as a "kit" on virtually any pool, whether new or existing. The invention is intended to be self-contained and made of materials familiar in the art, preferably polyvinyl chloride (PVC) piping, The (sic) exact limiting quantity of suction is determined by the internal dimensions and arrangement of the piping and sump.

(Zars at col. 2, ln. 41-47.)

4. U.S. Pat. No. 4,938,239 by Theurer states

[t]his advantageous combination of the compressed air discharging nozzle and the suction inlet port results in a reinforced suction air flow because the path of this flow is exactly determined by the arrangement of the nozzle within the inlet port so that all the dirt is subjected to the downward pressure of the compressed air as well as the upward suction, which will cause a strong turbulence and detach even strongly adhering dirt particles from the ballast.

(Theurer at col. 3, ln. 30-38.)

5. U.S. Pat. No. 4,522,575 by Tischer states

the discharge pressure and suction pressure are easily determined design parameters . . .

(Tischer at col. 6, ln. 14-16.)

6. U.S. Pat. No. 3,939,065 by Einersson states

[t]he strength of the pressure and suction waves depends, besides by the design of the pulsation organs, mainly on the peripheral velocity of the drum relative to the peripheral velocity of the suspension in the liquid layers in question.

(Einersson at col. 2, ln. 41-45.)

(Copies of these patents are included in appendices to this Response.)

II. Argument

Claims 36-37 are pending.

Claims 36-37 are appealed.

Claims 36-37 are rejected by the Board based on a new ground – §112, ¶2.

Applicant requests the Examiner consider the definiteness of the pending claims.

The Board's decision dated July 29, 2003 reversed the Examiner's §102 rejection and raised a §112, ¶2 indefiniteness rejection. In doing so, the Board focused on independent claim 36's limitations concerning a splash controller that is (1) configured to draw a chemical toward itself; and (2) configured to generate a gas pressure. The Board specifically argued that *suction* applied *through* the splash controller, rather than the *configuration* of the splash controller, is what draws the chemical and generates the gas pressure. (Appeal Decision at p. 4-5.) Significantly, in support for this argument, the Board interpreted the term "configured" to mean "shaped." (*Id.* at p. 4.) As authority for this interpretation, the Board cited page 242 of MERRIAM WEBSTER'S COLLEGIATE DICTIONARY (10th ed.). (Appeal Decision at p. 4, footnote 1.) However, as cited above in part IA, that reference appears to offer a different definition. Specifically, the definition of the root word "configure" indicates that "configured" means "set up for operation." Moreover, the alternate source cited above in part IB indicates that the term "configured" is broad enough to encompass MERRIAM WEBSTER'S actual definition, the Board's stated definition, and more.

Namely, the ELECTRONIC DICTIONARY's definition of the root word indicates that "configured" broadly means "designed, arranged, set up, or shaped."

Moreover, one of ordinary skill in the art would be aware that suction is a function of the design, arrangement, set up, or shape (i.e. configuration) of a relevant device, as demonstrated by the patents cited above in part IC. For example, U.S. Pat. No. 6,311,365 by Dornier teaches that a "suction region" is defined by an "arrangement" of pressure chambers. (Dornier at col. 2, ln. 35-36.) European Pat. No. 1238766 by Caspar indicates that "the amount of suction applied" depends on the "shape" of a device's apertures. (Caspar at ¶[0013].) U.S. Pat. No. 6,341,387 by Zars discloses that a "quantity of suction" is determined by the internal dimensions and "arrangement" of piping. (Zars at col. 2, ln. 45-47.) U.S. Pat. No. 4,938,239 by Theurer instructs one of ordinary skill in the art that the path of a "suction air flow" is determined by an "arrangement" of a nozzle with an inlet port. (Theurer at col. 3, ln. 32-34.) U.S. Pat. No. 4,522,575 by Tischer discloses that "suction pressure" is a "design" parameter. (Tischer at col. 6, ln. 14-16.) U.S. Pat. No. 3,939,065 by Einersson indicates that the strength and press of "suction waves" depends in part upon the "design" of pulsation devices. (Einersson at col. 2, ln. 41-43.) Applicant contends that such knowledge is deemed to be imparted to one of ordinary skill in the art when considering the Specification's support for the definiteness of the terms at issue.

Further, the Specification in fact provides non-limiting support for designs/arrangements/set ups/shapes of splash controllers. Applicant cited the relevant portions in the Appeal Brief when summarizing the invention. (Appeal Brief at p. 2.) To reiterate, Applicant cited p. 3, ln. 18-19; p. 4, ln. 5-6; and FIGS. 1&2 (addressing vacuum port 18) for the general disclosure of a splash controller. For the specific limitation of a splash controller configured to draw the chemical toward itself, Applicant cited p. 4, ln. 3-5, 16-18 (addressing how the design/arrangement/set up/shape of vacuum port 18 allows application of suction to a particular area). For the specific limitation of a splash controller configured to generate the relevant gas pressure, Applicant cited p. 3, ln. 3-7, 16-18; and FIGS. 1&2. Applicant alerts the Examiner that p. 4, ln. 3-7, 16-18 are relevant to this limitation as well.

In addition, it is significant that the Board has acknowledged that suction draws the relevant chemical and generates the relevant gas pressure (and that the Specification discloses so). (*See* Appeal Decision at p. 5-6.)

Hence, because the Specification discloses a splash controller configured (i.e. designed, arranged, set up, or shaped) for suction; and suction draws the relevant chemical and generates the relevant gas pressure; then the Specification necessarily discloses a splash controller configured to draw the relevant chemical and generate the relevant gas pressure.

(Moreover, for reasons addressed in Appeal Brief, Hurtig cannot be interpreted as disclosing a component whose design, arrangement, set up, and/or shape meets claim 36's relevant configuration requirements. *See* Appeal Brief at p. 3-4.)

As a result, Applicant contends the claims meet §112's definiteness requirement and requests the Examiner's allowance of all of the pending claims.

Appendix 2:

Examiner's Response to BPAI's Instruction for U.S. App. Ser. No. 09/305,865



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/305,865	05/05/1999	PIERRE FAZAN	92-0461.02	2752

7590 10/08/2003

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EXAMINER	
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2811	

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**RESPONSE TO BPAI'S INSTRUCTION REGARDING SN 09/305,865*****BPAI's Instruction***

In BPAI's ruling made on July 23, 2003 (Paper No. 24) regarding SN 09/305,865, the examiner's rejections of claims 22-36 under 35 U.S.C. 103 were reversed; new ground of rejections under the second paragraph of 35 U.S.C. 112 was entered, and this application was remanded to examiner. Also in the ruling, the examiner was instructed to determine if the subject matter of claims 22 to 36 is adequately supported by the original application. More specifically, the examiner was instructed to review the specification to determine whether the insulator or insulative material as required by claims 22-36 is described as part of Appellant's invention.

Examiner's Response

After reviewing the specification, the examiner believes that the subject matter of claims 22 to 36 fairly complies with 35 U.S.C. 112, first paragraph, as explained below.

The subject matter at issue is whether the recited limitations regarding an insulating element, which is recited as "an insulation cap" in claim 22, "an insulator" in claim 25, "an insulative material" in claim 29, and "a top insulator" in claim 33, are reasonably supported by the original application. According to the original application, the device structure of the instant invention (see Fig. 3) comprises a top (or cap) layer (64) atop the gate electrode (74), wherein the top layer (64) is formed of an oxide or

nitride or a combination thereof (see page 9, lines 14-22 of the instant specification). As shown in Fig. 3, in view of the specification (particularly see page 10, lines 15-19), the top layer (64) is apparently patterned to have a width substantially same as that of the gate electrode (74) prior to the formation of the dielectric sidewall spacer (62). The lining layer 58 therein is formed through a re-oxidation process after the formation of the dielectric sidewall spacer (62). It reasonably supports the subject matter that the top layer (64) itself does not cover any of the sidewalls of the gate electrode, although the applicant uses a less definite term of "uncovering" to define such a subject matter in the amended claims.

It is true that the original application does not explicitly describe that such a top layer (64) is an insulating layer. However, the original application does explicitly specify that this top layer is formed of an oxide or nitride or a combination thereof (see page 9, lines 14-22 of the instant specification); and one of ordinary skill in the art would readily recognize that such a top layer is by natural an insulating one, since when an oxide layer is mentioned in the art, especially when mentioned together with a nitride layer, unless specified otherwise, it is normally meant to be an insulating layer (such as a gate oxide layer is a commonly recognized synonym of a gate insulator); and also since such a top layer formed atop the gate electrode is commonly formed with an insulating layer, otherwise it would be a part of the gate electrode if the top layer were not insulative, and it would then be inappropriate to call the layer (74) alone as the gate electrode. Evidence for showing that such a top layer is by natural an insulating one can be readily found in the prior art including the cited prior art references of Takeuchi (US 5,962,892;

Art Unit: 2811

see the insulating cap layer 5 in Figs. 4 and 7, also col. 7, lines 26-27 and lines 44-46) and Kim (US 5,693,549; see the insulating cap layers 24 and 34 in Figs. 4 and 5, also see col. 3, lines 21-22, col. 4, lines 22-23, and col. 6, lines 58-59).

According to MPEP § 2163.II, the analysis of whether the specification complies with the written description requirement calls for the examiner to compare the scope of the claim with the scope of the description to determine whether applicant has demonstrated possession of the claimed invention. Such a review is conducted from the standpoint of one of skill in the art at the time the application was filed (see, e.g., *Wang Labs. v. Toshiba Corp.*, 993 F.2d 858, 865, 26 USPQ2d 1767, 1774 (Fed. Cir. 1993)) and should include a determination of the field of the invention and the level of skill and knowledge in the art. Generally, there is an inverse correlation between the level of skill and knowledge in the art and the specificity of disclosure necessary to satisfy the written description requirement. Information which is well known in the art need not be described in detail in the specification. See, e.g., *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1379-80, 231 USPQ 81, 90 (Fed. Cir. 1986). In this case, based on the above analysis conducted from the standpoint of one of ordinary skill in the art at the time the application was filed, the examiner believes that the applicant has fairly demonstrated possession of the claimed subject matter of the insulating top (or cap) layer overlying the recited gate electrode. And, the original description also reasonably adequately describes how to form such an insulating top (or cap) layer.

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Therefore, the examiner concludes that the subject matter of claims 22 to 36 fairly complies with 35 U.S.C. 112, first paragraph.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shouxiang Hu whose telephone number is (703) 306-5729. The examiner can normally be reached on Monday through Thursday, 7:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Thomas can be reached on (703) 308-2772. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

SH



**SHOUXIANG HU
PRIMARY EXAMINER**